

REMARKS

The Applicant thanks the Examiner for the thorough consideration given the present application. Claim 2 is cancelled herein without prejudice to or disclaimer of the subject matter set forth therein. Claims 1 and 3-20 are pending. Claims 1, 5, 8, 9, 11, 15, 16, and 18 amended. Claims 1 and 11 are independent. The Examiner is respectfully requested to reconsider the rejections in view of the amendments and remarks set forth herein.

Drawings

It is gratefully appreciated that the Examiner has accepted the drawings.

Claim for Priority

It is gratefully appreciated that the Examiner has recognized the Applicant's claim for foreign priority.

Information Disclosure Statement

An Information Disclosure Statement is being submitted concurrently to submit an English Abstract of Japanese Laid Open Patent No. Sho. 54-120277, as discloses in paragraphs [0003] to [0005] of the specification as originally filed on September 15, 2003.

Rejection Under 35 U.S.C. § 112, second paragraph

Claim 16 stands rejected under 35 U.S.C. § 112, second paragraph. This rejection is respectfully traversed.

In order to overcome this rejection, the Applicant has amended claim 16 so that claim 16 now depends from claim 15, thereby correcting the deficiency pointed out by the Examiner. The Applicant respectfully submits that the claims, as amended, particularly point out and distinctly claim the subject matter which the Applicant regards as the invention. Accordingly, reconsideration and withdrawal of this rejection are respectfully requested.

Rejection Under 35 U.S.C. §102(b)

Claims 1, 2, 5-12 and 15-20 stand rejected under 35 U.S.C. §102(b) as being anticipated by Hoeptner III (U.S. 4,955,193), and claims 3, 4, 13, and 14 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Hoeptner III in view of design choice. These rejections are respectfully traversed.

Independent Claim 1

While not conceding the appropriateness of the Examiner's rejection, but merely to advance prosecution of the present application, independent claim 1 is amended to incorporate the subject matter of claim 2, thereby reciting a combination of elements directed to a heat shield for an internal combustion engine, including *inter alia*

wherein a small diameter section is provided on an end section of the first heat shield plate, and an end section of the second heat shield plate overlaps the small diameter section along a length of the exhaust system member, with a gap being provided in a radial direction between the small diameter section of the first heat shield plate and the end section of the second heat shield plate.

Support for the novel combinations of element set forth in independent claim 1 can be seen in FIGS. 4-7 as originally filed.

The Applicant respectfully submits that the combination of elements as set forth in independent claim 1 is not disclosed or made obvious by the prior art of record, including Hoeptner III.

According to the structure according to the amended claim 1, a gap is provided between the small diameter section of the first heat shield plate and an end section of the second heat shield plate. Thus, the wind, which is generated when a vehicle travels, goes through the gap. Accordingly, the cooling rate of the exhaust-system members can be enhanced.

Examiner asserts that, in Hoeptner III, the gap is formed between the first and second heat shield plate. However, in Hoeptner III, the heat shield plate is merely composed in such a manner that S-shaped members are superposed and connected each other. Note that it is not identified that, among the S-shaped members, which one corresponds to the first or second member. Further, in connecting portions of the S-shaped members, although the gap is formed between the small diameter section and the expanding diameter section, between the small diameter section of one of the connecting member and an end of other of the connecting member, the gap is not formed. Thus, the claimed invention is not disclosed in Hoeptner III.

At least for the reasons described above, the Applicant respectfully submits that the combination of elements as set forth in independent claim 1 is not disclosed or made obvious by the prior art of record, including Hoeptner III. Accordingly, reconsideration and withdrawal of this rejection are respectfully requested.

Independent claim 1 is in condition for allowance.

Independent Claim 11

In addition, independent claim 11 is amended herein to recite a combination of elements directed to a heat shield for an internal combustion engine, including *inter alia* wherein the first heat shield plate is formed as a single plate extending along at least half way along the curved section of the exhaust system member.

Support for the novel combinations of element set forth in independent claim 1 can be seen in FIGS. 4-7 as originally filed.

The Applicant respectfully submits that the combination of elements as set forth in each of independent claim 11 is not disclosed or made obvious by the prior art of record, including Hoeptner III.

In contrast to the present invention, as can be seen in Hoeptner III FIGS. 2-5, this document merely discloses “telescopically inter-fitting semi-annular shield members 13, ... which have modified S-shaped cross sections”. Thus, Hoeptner III fails to teach or “the first heat shield plate is formed as a single plate extending along at least half way along the curved section of the exhaust system member”, as set forth in independent claim 11.

At least for the reasons described above, the Applicant respectfully submits that the combination of elements as set forth in independent claim 11 is not disclosed or made obvious by the prior art of record, including Hoeptner III. Accordingly, reconsideration and withdrawal of this rejection are respectfully requested.

Independent claim 11 is in condition for allowance.

Dependent Claims

As noted, dependent claims 5, 8, 9, 15, 16, and 18 are amended.

All dependent claims are in condition for allowance due to their dependency from allowable independent claims, as well as for the additional novel limitations set forth therein.

For example, as for dependent claim 7, Examiner asserts that the first heat shield plate corresponds to an element 15 shown in Fig. 6a of Hoeptner III. However, the element 15 merely indicates a welded portion, the element 15 does not indicate the claimed projection section. Please see column 2, line 33.

Further, as for dependent claim 10, Examiner asserts that the Hoeptner III, does not disclose where the band member is provided. Specifically, the claimed feature of the band member wrapping around the intermediate portion of the first heat shield plate is not disclosed in Hoeptner III. Therefore, Examiner's assertion is not proper.

Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. §102(b) and §103(a) are respectfully requested.

All pending claims are now in condition for allowance.

CONCLUSION

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. It is believed that a full and complete response has been made to the outstanding Office Action, and that the present application is in condition for allowance.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, he is invited to telephone Carl T. Thomsen (Reg. No. 50,786) at (703) 208-4030 (Direct Line).

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§1.16 or 1.17, particularly extension of time fees.

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Respectfully submitted,
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